

8/21/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: : Calzificio FAP S.p.A.
Mark : BELLISIMA BY CALZIFICIO FAP
Serial No.: : 75/866,321
Filed: : December 7, 1999
Classes: : 25

New York, NY 10036
August 19, 2002

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF APPEAL

SIR:

Applicant(s) hereby appeal to the Trademark Trial and Appeal Board from the Office Action dated February 21, 2002 of the Examiner finally rejecting the above-identified application.

The item(s) checked below are appropriate:

☒ [X] The appeal fee of \$100.00:

☒ [X] is enclosed;

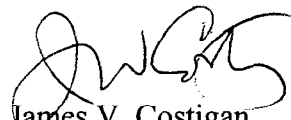
☐ [] not required (Fee paid in prior appeal)

☐ [] should be charged to Deposit Account No. 08-1540.

The Commissioner is hereby authorized to charge any additional fee(s) which may be required or credit any overpayment to Deposit Account No. 08-1540.

A duplicate copy of this paper is enclosed.

Respectfully submitted,



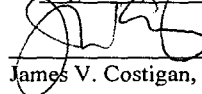
James V. Costigan
Registration No. 25,669

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Trademarks
2900 Crystal Drive, Arlington
VA 22202-3513

on August 19, 2002



James V. Costigan, Registration No. 25,669

TRADEMARK TRIAL AND APPEAL BOARD
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mark: BELLISSIMA BY CALZIFICIO FAP (and design)
Serial No.: 75/866321 Examiner: Michael Engel
Filed: April 3, 1998 Law Office: 108
Class(es): 25
Applicant: Calzificio FAP S.P.A.

New York, NY 10036
August 19, 2002

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

REQUEST FOR RECONSIDERATION

Sir:

Applicant herein requests reconsideration of the refusal to register the trademark
“BELLISSIMA BY CALZIFICIO FAP (stylized/and design?)” in the above-identified trademark
application.

The present application, Serial Number 75/866321, filed December 7, 1999, covers the
stylized mark BELLISSIMA BY CALZIFICIO FAP. The mark is depicted by tall capital
lettering, bold underscoring with smaller white capital lettering therein, and distinctive artistic
fonts. The mark is registered in Italy for use on stockings and tights in International Class 25
(Registration No. 760688). Accordingly, Applicant has completed the requirements for
registration under Section 44(e) of the Trademark Act.

The present application was amended once to place it in compliance with the Trademark Office requirements for registration. The second Office Action suspended examination of the present application pending disposition of Application Serial No. 75/706,827. The third Office Action was a Final Rejection issued by the Examining Attorney. The only outstanding issue remaining is the Examining Attorney's contention that the stylized mark BELLISSIMA BY CALZIFICIO FAP "when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 1334447 [BELLISSIMO] as to be likely to cause confusion, or to cause mistake, or to deceive." Office Action No. 1, page 1; May 3, 2000 (citing TMEP section 1207). The Examining Attorney's previous grounds for rejection have been addressed or rendered moot, and are no longer at issue in the present application.

The Examining Attorney erred in refusing registration of the mark BELLISSIMA BY CALZIFICIO FAP and erred in finding the mark so resembles the registered mark BELLISSIMO as to be likely, when applied to the goods of the applicant, to cause confusion. The Examining Attorney failed to consider the mark in its entirety, giving no weight to arbitrary portions of Applicant's mark and over emphasizing similarities between the laudatory and therefore weak portions of the two marks. The Examiner's rejection affords significantly too much strength to a single-word, merely laudatory, registered mark. Applicant's four-word compound mark, depicted in highly distinct stylized writing, and employing a different version of the laudatory term in combination with a fanciful term is not likely to cause confusion as used on different, non-competing goods. The overwhelming differences between the two marks in appearance, sound, connotation and commercial impression make it highly unlikely that there could be any confusion as to source of the goods on which they are used.

The Examiner is asked to consider the two step DuPont analysis in conjunction with the present application. In the first step, the marks are considered themselves for similarities in appearance, sound, connotation and commercial impression. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the second step, the goods or services are compared to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983).

It is well established that for purposes of Section 2(d) of the Trademark Act, the Applicant's mark is to be considered in its entirety. Viewed in its entirety, the subject mark is so different from the registered mark that there is no likelihood of confusion. With regard to the appearance of Applicant's BELLISSIMA BY CALZIFICIO FAP mark, it is written in stylized lettering and has no flower design. The registered mark, BELLISSIMO, is written in very different stylized letters and is associated with a delicate flower design. The lettering of the BELLISSIMO mark, with only the first letter capitalized, is a soft, angled script, rising over the delicate flower design below. The BELLISSIMA BY CALZIFICIO FAP mark, by contrast, consists of all capital letters, in a strong, printed (non-capitalized) font, written straight across with "BELLISSIMA" underscored by a thick black underline on which "BY CALZIFICIO FAP" is superimposed in contrasting white lettering. More particularly, one notes that the BELLISSIMO mark is a single word while Applicant's BELLISSIMA BY CALZIFICIO FAP mark consists of four words. BELLISSIMO is a readily familiar, laudatory and therefore merely descriptive Italian word, pronounced quickly and without difficulty; BELLISSIMA BY CALZIFICIO FAP is fanciful and lyrical.

The remarkable differences in appearance, lettering, wording and sound of the two marks are more than effective in distinguishing the two different sources of goods. In short, viewed in their

entirety as they appear to the consumer, there is nothing similar at all in the appearance, depiction or sound of these two marks. Thus, viewed in their entirety as they appear on their respective goods, nothing in the marks' appearance, wording, depiction or sound would cause confusion as to the origin of the products they designate.

In addition, the combination of appearance, depiction and sound of the two marks also conveys an entirely distinct commercial impression. The two highly stylized marks convey the unique, individual attitudes of the marks' owners. In identifying apparel items, the styling of the mark conveys an especially important consumer connotation and commercial impression. The cursive, soft, lowercase writing of the BELLISSIMO mark, accompanied by a flower, conveys a soft, 'cozy' impression for children's dresses. In contrast the harsh capital lettering of the BELLISSIMA BY CALZIFICIO FAP mark conveys a deliberately distinct commercial impression appropriate to identify the source of stockings.

The Examining Attorney contends, however, that because the words 'bellissimo' and 'bellissima' differ by only one letter, Applicant's entire mark is rendered confusingly similar. However, even the one letter difference between the cited terms conveys a significant gender distinction to the marks. The term 'bellissimo' is used to depict the masculine gender while 'bellissima' is used to depict the feminine gender. Although the Examining Attorney argues that this distinction has no value in the United States, masculine and feminine word forms are well known to Americans because they are prevalent in so many foreign languages and are taught throughout the country in any first year foreign language course.

In reciting the foregoing litany of differences between the two marks, Applicant argues, not for a side-by-side comparison of the marks and inspection of slight differences that might distinguish them in the minds of consumers. Applicant argues, rather, that the immediate,

obvious and unmistakable differences predominate to such a degree that a consumer would never mistake products labeled with these marks as originating from the same source.

Despite the anti-dissection doctrine, the Examining Attorney failed to even consider the fanciful wording 'FAP' as part of the compound mark. Moreover, the Examining Attorney summarily disposes of the entirely distinct source-indicating wording, 'BY CALZIFICIO FAP,' merely by reciting: "and the other wording, which means 'hosiery factory', [sic] is lacking in source indicating power." Action No. 3, February 19, 2002; page 2. Contrary to this assertion, 'BY CALZIFICIO FAP' clearly distinguishes the source of the BELLISSIMA BY CALZIFICIO FAP products from the products marketed under the BELLISSIMO mark. When translated loosely into English, the wording that was never even considered by the Examining Attorney becomes even more indicative of source: 'by FAP hosiery factory.' Properly considered, the wording 'by FAP hosiery factory' clearly distinguishes the origin of the products, hosiery. Moreover, 'fap' is an entirely fanciful term that further distinguishes the two marks. As a fanciful term, it should be afforded strong weight. This critical element was never addressed by the Examining Attorney and played no part in his analysis of the likelihood of confusion between the two marks.

The Examining Attorney also argues that the 'bellissima' portion of Applicant's mark predominates to such a degree that all the other differences between the marks have no weight in distinguishing the source of goods. When the mark is viewed in its entirety however, the 'bellissima' portion of applicant's mark predominates only in terms of the size of the design portion of the mark. More importantly, 'bellissima' and 'bellissimo' are merely laudatory terms and therefore similarities between the two are entitled to less weight, not more. *See, e.g. In re Boston Beer Co. L.P.*, 35 USPQ2d 1056 (CAFC 1999), (holding laudatory term descriptive and

unregisterable). In light of the weakness of the term 'bellissimo' in the registered mark, the Examining Attorney placed too much emphasis on the similarities of the 'bellissima' portion of Applicant's mark. As a result, the Examiner's rejection goes too far in establishing that a prior use of a single laudatory mark renders another mark employing, even in small part, a different version of that laudatory term likely of causing confusion and incapable or being registered.

It is clear in this case, that a highly stylized four-word compound mark that merely shares a different version of one laudatory term in common with another mark on designated goods that are not identical and do not compete should not be refused registration under Section 2(d). Such a holding would give far too much to the user of a sole laudatory word, effectively removing any and all marks employing a single laudatory term from the universe of marks capable of identifying one's products. The cases that the Examining Attorney cites are easily distinguishable from the present case and, moreover, do not support such a far-reaching proposition.

The Examining Attorney cites several cases to support his giving greater weight to the 'bellissima' portion of Applicant's mark. However, none of these cases is on point. *In re National Data Corp.*, 224 USPQ 749, 751 held that two compound marks, CASH MANAGEMENT ACCOUNT and CASH MANAGEMENT EXCHANGE, differing by only a single word, were not distinct because the two different words, while not synonyms, both have a connotation of monetary transactions. In that case, the court discussed how a longer and longer string of identical generic words may increase the similarity between marks, even though generic words are generally to be discounted when comparing the similarities between the marks. In the present case, however there is no string of generic words in common, only a single laudatory term in both marks followed by a string of distinct words in Applicant's mark and not found at

all in the registered mark. Moreover, Applicant, in this case, does not rely on the difference of a single word in the two marks; Applicant's mark is distinguished by three unique source-indicating words. The Examining Attorney, on the other hand, relies on the similarity of a single laudatory word in the two marks.

Tektronix, Inc. V. Daktronics, Inc., 534 F.2d 915, 189 USPQ 749, 751 (Fed. Cir. 1985), a case involving highly suggestive portions common between two marks, and cited by the Examining Attorney actually supports registration of the present mark. That case holds that, where there is no evidence of reliance on radio advertising, the differences in the pictorial portion of the mark may be given more weight in considering the marks in their entireties to find no likelihood of confusion. The court specifically refuses in that case to reach the issue of whether a portion of a mark is dominant. Similarly, in the present case, the obvious differences in the pictorial representation of the two marks should also carry more weight.

In re J.M. Originals, Inc., 6 USPQ2d 1393 (TTAB 1988) the Board held that the common 'JM' portion of JM ORIGINALS and JM COLLECTABLES marks was arbitrary and therefore indicative of source such that consumers would consider JM ORIGINALS and JM COLLECTABLES different clothing lines issued from the same 'JM' source. That case does not support the proposition that the entirely distinct BY CALZIFICIO FAP wording, in combination with a weak laudatory term is incapable of distinguishing Applicant's mark from the laudatory term alone. Furthermore, the present application does not share any arbitrary term in common with the registered mark, only a different version of a merely laudatory word. Moreover, it does not differ by merely that one term alone, but rather by three source-identifying words.

The Examining Attorney also cites *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.) to support that "the points of similarity are of greater importance than the

points of difference.” That case, however, involved two marks, SUNVIS and UNIVIS, that were merely two syllables and differed by only one of those syllables. Moreover, the marks were used on nearly identical products, lubricating oils. In comparing such two-syllable marks on identical products, it may necessarily be true that the similarities are of greater importance than the points of difference. However, that case does not support the proposition that any similarity between visually distinct, compound marks used on different, non-competing goods renders the marks confusingly similar.

In urging that the test for confusion is not whether the marks can be distinguished by a side by side comparison but whether the marks create the same overall impression, the Examining Attorney cites *Visual Information Institute, Inc. v. Vicon Industries, Inc.* The Trademark Trial and Appeal Board considered in that case two marks that were found to be arbitrary and practically identical (“VII” and “Vii”). In that case, one party offered testimony of an industrial designer to show that he could distinguish between the marks. That case is not on point and does refute Applicant’s argument that the previously recited numerous, very obvious and significant differences in Applicant’s mark distinguish it from the weak registered single, laudatory word mark.

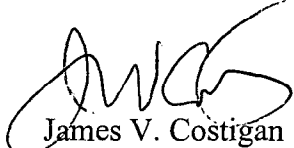
The Examining Attorney cites a string of cases in both Office Actions for the proposition that children’s dress and women’s stockings are so related as to cause confusion. However, in both *In re Mr. Wiggs Department Stores*, 175 USPQ 719 (TTAB 1972) and *In re Sox Unlimited, Inc.*, 169 USPQ 682 (TTAB 1971) the board also found the marks to be substantially identical. In the other cases cited by the Examining Attorney, the marks involved were also nearly identical in every respect; none differ so much as three letters. Thus, these cases are distinguishable from the present case where the marks BELLISSIMO and BELLISSIMA BY CALZIFICIO FAP differ by

more than four words. It is well established that the more similar the marks are, the less similarity between the goods is required for likelihood of confusion to arise. Thus, it is also true that the less similar the marks, the more similar the goods have to be to create the likelihood of confusion.

In the present case, the Examining Attorney overstates the similarity between the two marks in order to argue that children's dresses are so related to women's stockings as to create a likelihood of confusion. In the present case, involving very different stylized marks, children's dresses and women's stockings will not be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that different goods identified by such different marks come from a common source.

Based on the foregoing, Applicant respectfully requests that the refusal to register the present mark be withdrawn and that the mark be approved for publication.

Respectfully submitted,


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